

REMARKS**Claim Objections**

Claims 63, 66, 76, and 77 have been amended to overcome the informalities objections.

Continued Examination

Claims 40-81 are now pending in the present application. Claims 59, 63, 66, 76, and 77 have been amended. Applicants have provided arguments to rebut the Examiner's rejections and respectfully request allowance of all claims.

Objection to Reliance on Official Notice and Inherency

Applicants object to Examiner taking official notice (pages 10, 11, 15 and 20 of the action) and claiming inherency (pages 3 and 8 of the action). If Examiner intends to maintain a rejection that relied on claims of Official Notice and Inherency, Applicants request that Examiner provide specific references in lieu of making unsupported claims. MPEP 2144.03. Moreover, as it relates to claims of inherency, Applicants request that Examiner prove that the allegedly inherent characteristics are truly inherent.

Objection to All 103 Rejections For Failure to Provide Any Suggestion or Motivation to Combine

As discussed below, Examiner made several 103 rejections based on multiple references. Applicants have reviewed each of those rejections and cannot find any attempt on the Examiner's part to show a motivation to combine the relied upon references. Applicants point out that such a showing is required to support each and every 103 rejection. Because the Examiner has failed to show any suggestion or motivation to combine the references relied upon in the 103 rejections, each of the 103 rejections represents a case of impermissible hindsight and must be withdrawn.

Claim Rejections – 35 USC § 102

Claims 59, 60, and 62 stand rejected under 35 USC § 102(a) over PCT Publ. No. WO 99/43136 (“Rydbeck”). Claims 68-70 and 72-76 stand rejected under 35 USC § 102(e) over U.S. Patent No. 6,247,130 (“Fritsch”). Applicants respectfully traverse these rejections.

Claims 59, 60, and 62 were rejected under 35 USC § 102(a)

In order for a 102(a) rejection to be proper, each and every element must be present within the cited reference. Claim 59, as amended, discloses in addition to other limitations, “altering playing of the audio file using a player operable to play multiple audio file formats in response to detecting the cellular telephone call”. Rydbeck fails to disclose the limitation as claimed. Rydbeck discloses storing audio files within a memory for outputting audio files via a headset (see Abstract). Rydbeck is silent about specific audio file formats and also fails to disclose outputting one or more audio files based on a specific file format using a player operable to play multiple file formats. As such, given the limitations presented in amended Claim 59, which are not found within Rydbeck, Rydbeck cannot anticipate Claim 59.

Additionally, Claims 60 and 62 depend from Claim 59. Therefore, Applicants respectfully submit that the above arguments presented with respect to Claim 59 apply equally to Claims 60 and 62. Applicants respectfully request the withdrawal of the 102(a).

Claims 68-70 and 72-76 were rejected under 35 USC § 102(e)

In order for a 102(e) rejection to be proper, each and every element must be present within the cited reference. Fritsch fails to disclose each and every element of Independent Claim 68. Claim 68 recites, in addition to other limitations, a system that includes “an Internet website provided in association with a cellular communication device operable to receive and play an audio file selected by a user accessing the Internet website external to the cellular communication device” and “a digital engine operable to determine availability of the cellular communication device and to communicate the audio file to the cellular communication device.”

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Fritsch fails to disclose the above limitations. Fritch only discloses a website to manage distribution of audio content using a unique key (see description of FIG. 4A) and is limited to delivery to a desktop or other tangible medium such as CD delivered in the mail to a subscriber (see description of FIG. 1D). Further, Fritsch fails to disclose a digital engine operable to determine an association made between a user logging in and a user's cellular communication device. Moreover Fritsch fails to determine the availability of the cellular communication device to communicate the audio file(s) to the user's cellular communication device. These limitations are not present in Fritsch. Therefore, Fritsch fails to provide a system for presenting an Internet website associated with cellular communication devices for communicating audio files upon determining an availability of the cellular communication device in association with a user login. As such, the limitations of Claim 68 are not present with Fritsch.

Claims 69-70, 72-76 depend from Claim 68. Therefore, Applicants respectfully submit that the above arguments presented with respect to Claim 68 apply equally to these claims and respectfully requests the withdrawal of the 102(e) rejection.

Rejections under 35 U.S.C. § 103

In order to establish a prima facie case of obviousness, the Examiner must show that three criteria are met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. M.P.E.P. 2143. Applicants respectfully submit that a prima facie case of obviousness has not been met and traverse each and every 103 rejection.

Claims 40, 41, 43-46, and 50-55 were rejected under 35 USC § 103(a)

Claims 40, 41, 43-46, and 50-55 were rejected under 35 USC § 103(a) over Rydbeck in view of U.S. Patent No. 6,721,710 ("Lueck"). Applicants respectfully traverse this rejection.

As indicated above, the Examiner has failed to show any suggestion or motivation to combine the references. Each 103 rejection represents a case of impermissible hindsight.

Moreover, as described more fully below, the combination of the Rydbeck, Lueck and Cao references does not disclose all the limitations of the claims.

As recited above, Independent Claim 40 has been amended to obviate the above rejection. Claim 40 includes, in addition to other limitations, "a memory module operable to store plural audio formats of one or more audio files" and "a processor operable to alter a playing of at least one of the audio files in response to the incoming telephonic communication use a player operable to play multiple audio formats."

Rydbeck and Lueck, either alone or when combined, fail to provide the limitations of amended Claim 40. Moreover, there is no motivation or suggestion within Rydbeck and Lueck to combine such references to disclose the invention of Claim 40. Lueck provides a method for converting audio formats to a single audio format prior to playing the audio format in an effort to allow for fast-forwarding through and retrieving blocks of data (see abstract). Additionally, as discussed above, Rydbeck fails to provide an audio player or processor operable to play plural audio formats. As such, Rydbeck and Lueck fail to disclose or suggest the necessary limitations to make obvious Claim 40.

Claims 41-55 depend from amended Claim 40. Therefore, Applicants respectfully submit that the arguments presented with respect to Claim 40 apply equally to these claims and respectfully request the withdrawal of the 103 rejection.

Claims 56-58 were rejected under 35 USC § 103(a)

Claims 56-58 were rejected under 35 USC § 103(a) over Rydbeck in view of Lueck, and in further view of Fritsch.

In order to establish a prima facie case of obviousness, the Examiner must show that three criteria are met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. M.P.E.P. 2143. Applicant respectfully submits that a prima facie case of obviousness has not been met, at least because the combination of the Rydbeck in view of Lueck, and in further view of Fritsch references do not disclose all the limitations of the claims.

Rydbeck is drawn towards a cellular telephone operable to output music (see Abstract). Rydbeck fails to disclose playing an audio file stored locally on a cellular telephone and communicating it via a BlueTooth communication module. Rydbeck further fails to disclose receiving a cellular telephone communication and communicating the cellular telephone communication using the same Bluetooth communication module. Further, Rydbeck does not suggest using Bluetooth communication to communicate a playing of an audio file and a telephonic communication and using the same BlueTooth communication module to a speaker Bluetooth enabled speaker. Additionally, it is not obvious, nor has the Examiner presented, how the communication device of Rydbeck may be modified to accomplish such a task. As such, Rydbeck fails to provide the elements to make obvious the limitations presented in Claim 56.

Additionally, Lueck likewise fails to disclose the limitations as presented in Claim 56. Lueck temporarily stores audio files having multiple audio formats only to convert multiple audio formats to a single audio format prior to playing the converted audio file using a processor (see Col 5 line 48 to Col 6 line 17). Lueck creates an alternative file format for efficient scanning of audio content by a processor (see Abstract).

Claim 56 discloses a memory that stores multiple audio files having multiple audio file formats to be played using a single processor operable to play plural audio formats. As such, Lueck teaches away from the limitations of Claims 56 and therefore does not provide the necessary elements or limitations that may be used to make obvious Claim 56.

Finally, Fritsch fails to disclose an Internet website accessible external to a cellular communication device that provides a user accessing the login page using a login associated with the cellular communication device as recited in Claim 56. Fritsch discloses a website that allows for accessing of songs to select music that may be delivered via a tangible medium to a desktop computer or through the mail. For example, a user may "...get those delivered immediately via digital delivery over the internet to her PC; additionally, all other orders of finished product entered into the shopping list will be shipped to her home by mail, such as a private courier, for example." (See Fritch Col 5, line 67 – Col 6 line 13). Fritsch fails to teach or suggest providing an "Internet website external to the cellular communication device and operable to provide the user access to plural audio files via a user login" wherein the communication module is further

operable to "receive an audio file selected by a user". The only mechanism provided by Fritch is to receive the audio file from the requesting PC or through the mail. As such, Fritch when combined with Rydbeck, or Lueck fails to make obvious Claim 56.

Claims 57-58 depend from amended Claim 56. Therefore, Applicants respectfully submit that the arguments presented with respect to Claim 56 apply equally to these claims and respectfully requests the withdrawal of their rejection.

Claim 81 was rejected under 35 USC § 103(a) over Fritsch in view of Bottum, and further in view of Rydbeck.

Claim 81 depends from Claim 78, which has been shown to be allowable. Therefore, Applicants respectfully submit that claim 81 is allowable. Furthermore, there is no suggestion or motivation to combine the cited references.

Claim 61 was rejected under 35 USC § 103(a) over U.S. Pat. No. 6,496,692 ("Shanahan")

Claim 61 depends from Claim 59, which has been shown to be allowable. Therefore, Applicants respectfully submit that claim 61 is allowable. Furthermore, there is no suggestion or motivation to combine Shanahan with the other relied upon references.

Claims 63-67 were rejected under 35 USC § 103(a) over Rydbeck in view of Cao

Claims 63-67 depend from Claim 59, which has been shown to be allowable. Therefore, Applicants respectfully submit that claims 63-67 are allowable. Furthermore, there is no suggestion or motivation to combine the cited references.

Claim 71 was rejected under 35 USC § 103(a) over Fritsch in view of Rydbeck

Claim 71 depends from Claim 68, which has been shown to be allowable. Therefore, Applicants respectfully submit that claim 71 is allowable. Furthermore, there is no suggestion or motivation to combine the cited references.

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Claim 77 was rejected under 35 USC § 103(a) over Fritsch

Claim 77 depends indirectly from Claim 68, which has been shown to be allowable. Therefore, Applicants respectfully submit that claim 77 is allowable. Furthermore, there is no suggestion or motivation to combine the cited references.

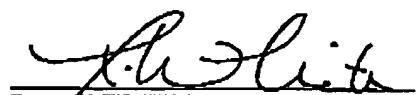
Claims 78-80 were rejected under 35 USC § 103(a) over Fritsch in view of U.S. Pat. No. 6,014,569 ("Bottum")

Claims 78-80 depend directly or indirectly from Claim 68, which has been shown to be allowable. Therefore, Applicants respectfully submit that claims 78-80 are allowable. Furthermore, there is no suggestion or motivation to combine the cited references.

CONCLUSION

Applicants respectfully submit that the present application is now in condition for allowance. Accordingly, the Examiner is requested to issue a Notice of Allowance for all pending claims. If, for any reason, the Office is unable to allow the Application on the next Office Action, and believes a telephone interview would be helpful, the Examiner is respectfully requested to contact the undersigned attorney or agent. The Commissioner is hereby authorized to charge any fees, which may be required, or credit any overpayment, to Deposit Account Number 50-3797.

Respectfully submitted,

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